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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MARK FREIER, EBERHARD KORNER,
and HELMUT HECKELE

Appeal 2008-1058
Application 10/002,523
Technology Center 3700

DECIDED: February 28, 2008

Before
TONI R. SCHEINER, LORA M. GREEN, and RICHARD M. LEBOVITZ,
Administrative Patent Judges.

SCHEINER, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 8 and 10-19, all the claims remaining in the application. The claims stand rejected as obvious over the prior art. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

DISCUSSION

The claimed invention is directed to an instrument for endoscopic excision and retrieval of a sample of cartilage material (Spec. 3).

Claim 8 represents the invention in its broadest aspect, and reads as follows:

8. An endoscopic sample taker for collecting a sample of cartilage material, comprising:
 - a hollow shank having a distal end and a proximal end;
 - a scoop fixedly connected to said distal end of said hollow shank and defining a spoon-shaped trough having an opening and a closed end;
 - a handling means connected at said proximal end of said hollow shaft and having an actuation mechanism;
 - an actuating rod having a distal end and a proximal end axially movable in said hollow shank, said proximal end of said actuating rod releasably connectable with said actuation mechanism; and
 - a covering comprising a tongue having a longitudinal length with a first end fastened proximate said distal end of said actuating rod and a second distal end, said tongue being slidably adjustable so that said tongue slides along a longitudinal length of said tongue in response to axial adjustment of said actuating rod to an adjusted position between a closure position and an open position, wherein said open position of said tongue allows ingress of the cartilage material to said trough and said closure position covers said trough to prevent loss of the cartilage material from said trough, said adjusted position being maintained without external force on said actuating rod.

Claims 8 and 10-19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Salerno (U.S. Patent 4,953,559, issued September 4, 1990) and Falk (U.S. Patent 4,569,131, issued February 11, 1986).

Salerno describes a catheter for endocardial biopsy, as illustrated in Figures 1, 2 and 4, reproduced immediately below:

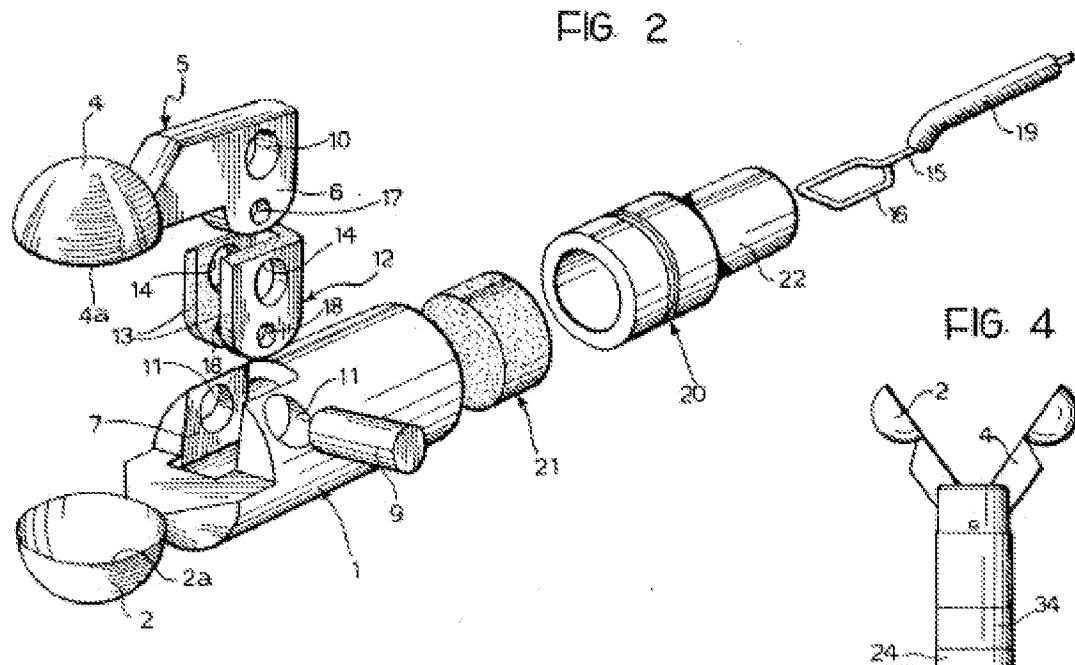
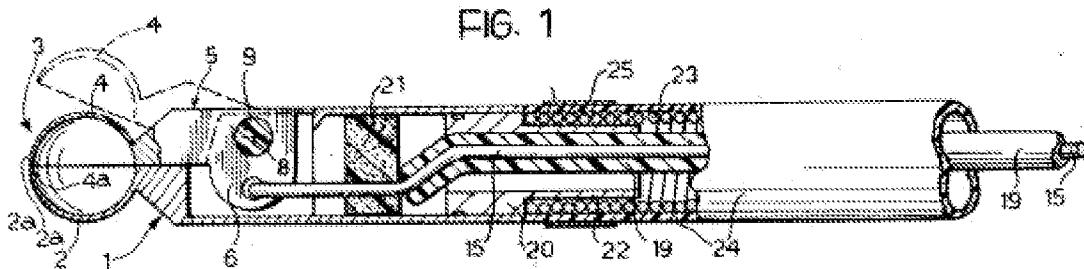


Figure 1 of Salerno depicts a section of the distal end of the catheter; Figure 2 is an exploded perspective view of the part illustrated in Figure 1; and Figure 4 is a schematic view of one embodiment of the distal end of the catheter (Salerno, col. 2, ll. 31-42).

The Examiner contends that “Salerno discloses hollow shank 1, scoop 2 which defines a spoon-shaped trough having an opening . . . and a closed end . . . [an] actuating rod 15 and [a] covering (the combination of parts 4, 5 and 12 which are secured together) comprising a tongue” (Ans. 4).

According to the Examiner, “member 4, 5, 12 is a ‘tongue’ since it is flat, planar, wide and long along most of its length, i.e., along portions 5 and 12 . . . said tongue being slidably adjustable so that said tongue slides along a longitudinal length of said tongue” (Ans. 4).

The Examiner’s interpretation of Salerno is incorrect.

Salerno’s catheter “includes, at its distal end, a substantially tubular body **1** which terminates at one end in a spoon-like appendage **2** constituting one of the jaws of a pair [of] biopsy forceps **3**. The spoon-like appendage **2** has a free cutting edge **2a** which extends through approximately 320°. The other jaw of the forceps is constituted by a spoon-like appendage **4** which is similar in shape to the spoon-like appendage **2** and has its cavity facing that of the appendage **2**. The appendage **4** also has a circumferential free cutting edge **4a** which cooperates with the edge **2a** to effect the removal of the heart tissue. The appendage **4** is carried by a support lever **5** which has a flat part **6** housed in a transverse notch **7** formed in the supporting body **1**. The lever **5** is articulated to the supporting body **1** about a transverse axis **8** by means of an articulation pin **9**” (Salerno, col. 2, ll. 47-62).

In short, Salerno’s appendage **4** is spoon-shaped, as it mirrors the shape of appendage **2**, with which it cooperates. Appendage **4** may be a covering for appendage **2**, but it is not a tongue, with or without support lever **5** and insulating body **12** which connects it to supporting body **1** (Salerno, col. 3, ll. 6-30).

More importantly, appendage **4** does not slide between open and closed positions along a longitudinal axis as in claim 8. Rather, “lever **5** . . . rotate[s] about [transverse] axis **8** relative to the supporting body **1** so as to move the jaw **4** between a closed position (shown in continuous outline in FIG. 1) and an open position (illustrated in broken outline). In the closed position, the two cutting edges **2a**, **4a** meet each other and the two spoon-like appendages define a closed cavity for containing the tissue sample taken” (Salerno, col. 3, ll. 14-21).

As all of the rejected claims require a tongue-shaped covering that slides longitudinally to cover a spoon-shaped trough, and Salerno does not teach or suggest a covering that meets this limitation, and Falk does nothing to cure this deficiency, we find that the Examiner has not established an adequate factual basis for rejecting the claims as unpatentable over the prior art.

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Accordingly, the Examiner's rejection of claims 8 and 10-19 under 35 U.S.C. § 103(a) is reversed.

REVERSED

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